

REMARKS

Included herein is a request for a three-month extension of time along with the appropriate fee.

In the Office Action mailed 3/8/2005, 1-13 were rejected as being obvious over the prior art under 35 U.S.C. §103. Claim 14 was indicated as being allowable if rewritten in independent form including all of the limitations of the base claim (claim 1).

In response, Applicant has herein amended claim 1 to more clearly distinguish the claimed invention from the cited prior art, despite Applicant's belief that such amendment was necessary, but to expedite reissue of the instant patent. Applicant now respectfully asserts that the claims are in condition for allowance and reissue.

Patentability of Claim 1 (as amended) and claims dependent thereon

The Examiner has cited the combination of *Brooks et al.*, and *Mayr*, U.S. Patent Nos 5,513,865 and 5,249,819, respectively, in rejecting Applicant's independent claim 1. It is respectfully noted that *Mayr* was cited by this Examiner in unsuccessfully preventing the patenting of the parent application to this reissue application.

In his Office Action, the Examiner concludes that while the limitation of "extrusion" is not found in either of these references (or any other reference), he indicates that "it would have been obvious to use an extruded aluminum to make the board of *Brooks* for the purpose of employing an inexpensively available material. Applicant respectfully disagrees with the Examiner on this point for several reasons. First, Applicant's claimed invention is not just "an extruded aluminum," but is instead a particular configuration of *specialty* extrusion that is used to make Applicant's skateboard deck (such as is claimed by

Applicant) – it is absolutely not the application of a pre-existing extrusion to a new application, but is instead a new extrusion specifically created for Applicant's skateboard. Second, while Brooks may hint at a material choice of aluminum, there is certainly no disclosure regarding the use of extruded aluminum. Third, aluminum, and more particularly extruded aluminum is decidedly not a low-cost approach for making a skateboard deck, but is instead one of the most expensive approach – the wood deck of Brooks or a plastic deck are the cheapest versions available. Fourth, Mayr has nothing to do with skateboard decks, but rather deals with a ski design having a hollow body of uniform width. There is no suggestion or hint in either Mayr or Brooks to combine these two references; as such, the Examiner cannot rely on these non-analogous references absent some representation as to the evidence available to one of ordinary skill in the art that would lead one to combine these references. Finally, assuming, arguendo, that the Examiner is correct in concluding that making devices from extruded aluminum is old, the lack of a single reference employing such approach to make a skateboard (or even a ski or snowboard), is evidence that the art teaches away from Applicant's novel and nonobvious approach.

Since each and every element of Applicant's claimed invention is not disclosed or hinted at by the combination of the cited references, and since there is no suggestion to combine these references, and further because the references teach away from Applicant's claimed invention, the Examiner has failed to make out a prima facie case of obviousness, and this claim 1 and all claims dependent thereon must be allowed.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

STEINS & ASSOCIATES

A handwritten signature in black ink, appearing to read 'Karl M. Steins', is written over a horizontal line.

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